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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/922,818

08/06/2001

Eun Sam Kim

2080-3-31

8857

35884 7590 09/12/2007  
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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

09/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/922,818

Applicant(s)

KIM, EUN SAM

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/28/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments, filed 06/28/2007, have been entered and made of record. Claims 1-24 are pending.

### ***Response to Arguments***

2. The affidavit filed on 06/28/2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Middleton reference.

3. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Middleton reference. See the reasons sets forth below.

4. The declaration of the affidavit filed on 06/28/2007 was made by an assignee, however there is no statement stating that the inventor could not produce the affidavit. MPEP § 715.04 states "Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest *when* it is not possible to produce the affidavit or declaration of the inventor(s)."

5. No statement can be found stating that the acts relied upon must have been carried out in this country or a NAFTA or WTO Member Country. See MPEP § 715.07 (c).

6. The invention must be recognized and appreciated for a reduction to practice to occur. There can be no conception or reduction to practice of a new form or of a process using such a new form of an otherwise old composition where there has been no recognition or appreciation of the existence of the new form. In addition the same evidence sufficient for a constructive

reduction to practice may be insufficient to establish an actual reduction to practice, which requires a showing of the invention in a physical or tangible form that shows every element of the count. See MPEP § 2138.05.

7. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Middleton reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception.

8. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Middleton reference to either a constructive reduction to practice or an actual reduction to practice. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. In addition an applicant must account for the entire period during which diligence is required. A statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading. A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed Cir. 1983) (37 CFR 1.131 issue). Diligence requires that applicants must be specific as to dates and facts.

Therefore the cited reference of Middleton still applies and the rejection is maintained.

***Claim Rejections - 35 USC § 103***

Art Unit: 2621

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-9, 11-19, 21, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelley (US Pat. No. 6,795,638) in view of Middleton (US PG PUB. 2002/0118300).

Regarding claim 1, Skelley discloses a method for editing a digital broadcasting material, the method comprising the steps of:

clipping segments from the digital broadcasting material consisting of program segments and being recorded in a recording medium in a stream type (see col. 4 lines 48-62, col. 5 lines 38-51 and line 52-col. 6 line 3);

recording the clipped segments as new programs, respectively (see col. 5 lines 38-51 and line 64-col. 6 line 10 and lines 25-34, and col. 7 lines 46-54) ; and

wherein the step for clipping the segments comprises the steps of:

reproducing the digital broadcasting material (see col. 6 lines 23-31); and

selecting a predetermined period of the digital broadcasting material, by designating a start point and an end point thereof (see col. 5 lines 14-29 and lines 43-65, col. 6 lines 28-31 and col. 7 lines 14-22).

Claim 1 differs from Skelley in that the claim further requires selecting some of the recorded programs, and merging the selected programs into a new program.

In the same field of endeavor Middleton discloses a method of viewing a sequence of media clips. Middleton discloses creating new programme from the clips stored in the memory (see page 1 paragraphs 0006-0007). Therefore in light of the teaching in Middleton it is obvious to one of ordinary skill in the art to modify Skelley by further creating a new program from the recorded clips in order to playback the programme of clips without discontinuities.

Regarding claim 3, Skelley discloses full streams of the digital broadcasting material are reproduced (see col. 4 lines 48-62 and col. 6 lines 23-26).

Regarding claim 4, Skelley discloses the digital broadcasting material is reproduced at intervals of a predetermined length (see col. 4 lines 34-62 and col. 5 lines 43-51).

Regarding claim 5, Skelley discloses a representative screen of the digital broadcasting material is reproduced (see col. 5 line 51-col. 6 line 3).

Regarding claim 6, Middleton discloses the step for selecting some of the recorded programs, and merging the selected programs into the new program comprises a step for designating an order of the selected programs (see paragraph 0006).

Regarding claim 7, Skelley discloses the step for selecting some of the recorded programs, and merging the selected programs into the new program comprises a step for recording a screen relating to the merged program (see figures 2 and 3).

Regarding claim 8, Skelley discloses a method for editing a program in a personal video recording system, the method comprising the steps of:

reproducing a program recorded by a user (see col. 4 lines 48-62);

clipping predetermined periods of the reproduced program by selecting a start point and an end point associated with each the predetermined periods (see col. 5 lines 22-30 and 43-51); and

recording the clipped predetermined periods (see col. 5 line 66-col. 6 line 3 and lines 31-34); and

Claim 8 differs from Skelly in that the claim further requires merging selected periods of the recording predetermined periods into a merged program.

In the same field of endeavor Middleton discloses creating a new program and selecting of the duration of the playback so that the clips are played in a shorter time or by providing a start time and end time relative to the beginning and end of the clip (see paragraph 0006). Therefore in light of the teaching in Middleton it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skelly by providing a predetermined periods into a merged program in order to adjust playback time.

Regarding claim 9, Skelley discloses the program recorded by the user is a broadcasting program recorded in a hard disk (see col. 3 line 62-col. 4 line 10 and 57-62, and col. 9 lines 28-41).

Regarding claim 11, Skellye discloses full streams of the program recorded by the user are reproduced (see col. 4 lines 34-62 col. 6 lines 20-26).

Regarding claim 12, Skelley discloses the program recorded by the user is reproduced at intervals of a predetermined length (see col. 5 lines 31-37).

Regarding claim 13, Skelley discloses a representative screen of the program recorded by the user is reproduced (see col. 5 line 51-col. 6 line 3).

Regarding claim 14, Skelley discloses a method for editing a program in a personal video recording system, comprising the steps of:

reproducing a recorded program (see col. 4 lines 48-62);

clipping predetermined streams from the reproduced program by selecting a start point and an end point associated with each the predetermined streams (see col. 5 lines 22-30 and 43-51);

recording the clipped streams (see col. 5 lines 38-51 and col. 6 lines 18-34);

Claim 14 differs from Skelly in that the claim further requires merging the recorded clipped streams, and recording the merged streams as a new.

In the same field of endeavor Middleton discloses merging the clipped streams (see rejection of claim 1 above), and recording the merged streams as a new program (see paragraphs 0007, 0015 and 0019).

Regarding claim 15, Middleton discloses the step for merging the clipped streams designates an order of the clipped streams, and merges the streams in the designated order (see paragraph 0006).

Regarding claim 16, Middleton discloses the step for merging the clipped streams merges a representative screen of the clipped streams (see figs 2-4).

Regarding claims 17-19, these claims are rejected for the same reason as discussed above in claims 3-5 respectively.

Claim 21 is rejected for the same reason as discussed in claim 1 above.

Regarding claim 23, Middleton discloses an order of the merged program segments in the new program is different from an order of clipping program segments (It is inherent that the new



program is created in different order than the original clipping program segments, see paragraph 0015 and 0030).

Regarding claim 24, claim 24 is rejected for the same reason as discussed in claim 1. It is noted that claim 24 recites that the new program has a unique program identifier and each broadcast program segment in the new program cannot be accessed individually. It is inherent that since the new program is recorded as a single file, each broadcast program segment cannot be accessed individually, and it is obvious to one of ordinary skill in the art that new ID is required to access the new program.

11. Claims 2, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelley in view of Middleton and further in view of Escobar (US Pat. No. 5, 659,793).

Regarding claim 2, claim 2 differs from Skelley and Middleton in that the claim further requires the digital broadcasting material is provided in a multiple number. Although Skelley does not specifically teach that the materials are provided in a multiple number, Skelley teaches the event database includes different event types (see col. 5 lines 43-48). Skelley also discloses related events can be added to the database from another source (see col. 5 lines 48-51).

In the same field of endeavor Escobar discloses the video assets are marked as beginning and ending point (see col. 11 line 61-col. 12 line 4). Escobar further discloses the assets are originated from different channels (see fig. 7 and col. 12 lines 4-5). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the proposed combination of Skelley and Middleton by providing broadcasting material in multiple number in order to retrieve objects from different server.

Claims 10 and 20 are rejected for the same reason as discussed in claim 2 above.

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skelley (US Pat. No. 6,795,638) in view of Middleton and further in view of Official Notice.

Claim 22 differs from the proposed combination in that the claim further requires at least one program segment of the clipped program segment is a thumbnail image. Although Skelly, Middleton or Escobar fail to disclose at least one program segment of the clipped program segment is a thumbnail image, Official Notice is taken that it is well known in the art to clip thumbnail images. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to clip thumbnail images in order to view multiple images on a screen.

#### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

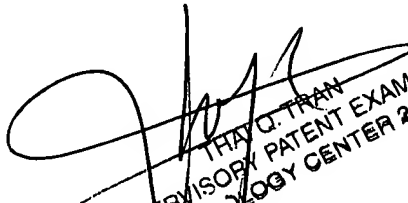
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru  
August 21, 2007

  
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